

REMARKS

By this Response, Applicant has amended claims 1, 12, 17, 24, 35, 40, 47, 58, 63, 70, 81 and 86. Support for the amendments to claims 1, 24, 47 and 70 may be found at least in original claims 17, 40, 63 and 86 of the originally-filed application. Thus, claims 1-92 remain pending in the application for examination on the merits.

In the Office Action¹, claims 1-23 were rejected under 35 U.S.C. § 101 as lacking non-statutory subject matter. Office Action at 5-6. Claims 1-12, 17, 19, 22-35, 40, 42, 45-58, 63, 65, 68-81, 86, 88, 91, and 92 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,774,554 ("Gilham") in view of U.S. Patent No. 6,385,504 ("Pintsov"). Id. at 6-14. Claims 13-16, 18, 20, 21, 39, 41, 43, 44, 59-62, 64, 66, 67, 82-85, 87, 89, and 90 under 35 U.S.C. § 103(a) as being unpatentable over Gilham in view of Pintsov, and further in view of Official Notice. Id. at 14-17.

Claims 1, 24, 47 and 70 are the only independent claims pending in the application. Concerning the rejections of independent claims 1, 24, 47 and 70, Applicant has amended those claims and respectfully submits that those claims comply with 35 U.S.C. §§ 101, 102(b) and 103(a) for at least the reasons outlined in more detail herein. Nevertheless, to the extent that the Examiner may consider rejecting those claims based on the references of record in the application, Applicant respectfully submits that independent claims 1, 24, 47 and 70 are patentably distinguishable from

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any Statement or Characterization in the Office Action.

those references, and such claim rejections would be improper for at least the reasons outlined herein.

I. Rejections For Alleged Non-statutory Subject Matter

In the Office Action, the Examiner rejected claims 1-23 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. By this Response, Applicant amends independent claim 1 to recite, *inter alia*, “comparing the verification data obtained from the delivery payment coding to a verification database.” Applicant submits that amended claim 1 complies with 35 U.S.C. § 101 and respectfully requests the reconsideration and withdrawal of the rejection of claims 1-23 under 35 U.S.C. § 101.

II. Rejections For Alleged Obviousness Based On Gilham and Pintsov

With respect to the rejection of claims 1-12, 17, 19, 22-35, 40, 42, 45-58, 63, 65, 68-81, 86, 88, 91, and 92 under 35 U.S.C. § 103(a) based on Gilham in view of Pintsov, Applicant respectfully submits that Gilham in view of Pintsov fails to disclose or render *prima facie* obvious all of the subject matter recited in independent claims 1, 24, 47 and 70. Specifically, Gilham in view of Pintsov fails to disclose or render *prima facie* obvious “comparing the verification data obtained from the delivery payment coding to a verification database.” See claims 1, 24, 47 and 70.

In the Office Action, the Examiner alleged that “[o]ne of ordinary skill in the art would have been motivated to modify the reference in order to allow mailer to prepare the mail item with the verification data.” Office Action at 7. Assuming arguendo that motivation asserted by the rejection statement provides sufficient motivation to the ordinary skilled artisan to combine Gilham and Pintsov, which Applicant does not

concede, the resulting hypothetical combination would fail to arrive at the claimed invention.

According to the M.P.E.P., “[t]he rationale to support a conclusion that the claim would have been obvious is that ‘a person of ordinary skill in the art would have been motivated to combine the prior art to achieve the claimed invention and that there would have been a reasonable expectation of success.’” § 2143(G) (quoting DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co., 464 F.3d 1356, 1360, 80 USPQ2d 1641, 1645 (Fed. Cir. 2006) (emphasis added)). Here, notwithstanding whether that alleged motivation exists, the subject matter recited in independent claims 1, 24, 47 and 70 cannot be achieved by combining Gilham and Pintsov.

Amended claims 1, 24, 47 and 70 all recite, *inter alia*, “comparing the verification data obtained from the delivery payment coding to a verification database.” At the very least, Gilson in combination with Pintsov fail to recite at least these exemplary elements recited in independent claims 1, 24, 47 and 70. Specifically, none of the applied references, whether view in combination or alone, describe “comparing the verification data obtained from the delivery payment coding to a verification database” as recited in claims 1, 24, 47 and 70.

Instead, Gilham’s describes comparing a decoded authentication code representing a destination to a destination location printed on the mail piece. Specifically, Gilham describes, “The identity number is then used (step 41) to decode the authentication code to yield a destination post code for the item. The destination post code yielded by step 41 is checked (step 42) with the destination code 15 read from the destination address printed on the item to provide a verification of authenticity

of the item.” Col. 4, ll. 26-30. Thus, Gilham uses the decoded authentication number and the printed destination address to authenticate the mail piece. Since the printed destination address is not a verification database, Gilham fails to teach “comparing the verification data obtained from the delivery payment coding to a verification database” as called for in the rejected independent claims.

Pintsov fails to remedy the deficient teachings of Gilham. Pintsov was cited for allegedly teaching “transmitting verification data configured to be included in a delivery payment coding” Office Action at 7. Irrespective of Pintsov’s disclosure of transmitting verification data, Pintsov also fails to teach “comparing the verification data obtained from the delivery payment coding to a verification database.” Consequently, the hypothetical combination of Gilham and Pintsov fails to achieve the subject matter recited in the claims.

Since the rejected claims call for a verification database, the failure of Gilham and Pintsov to teach “comparing the verification data obtained from the delivery payment coding to a verification database” is a large difference between the applied references and the rejected claims. Accordingly, the combination of Gilham and Pintsov does not achieve the claimed subject matter and a *prima facie* case for obviousness has not been established.

For at least the reasons outlined herein, the combination of Gilham and Pintsov cannot achieve the subject matter recited in independent claims 1, 24, 47 and 70. A *prima facie* case for obviousness was not established, and Applicant respectfully requests the reconsideration and withdrawal of the rejection of claims 1-12, 17, 19, 22-

35, 40, 42, 45-58, 63, 65, 68-81, 86, 88, 91, and 92 under 35 U.S.C. § 103(a) based on Gilham and Pintsov.

III. Rejections Under 35 U.S.C. § 103(a) Based On Gilham, Pintsov and Official Notice

Turning now to the rejection of claims 13-16, 18, 20, 21, 39, 41, 43, 44, 59-62, 64, 66, 67, 82-85, 87, 89, and 90 under 35 U.S.C. § 103(a) based on Gilham in combination with Pintsov and Official Notice, Applicant respectfully submits that the rejection statement's hypothetical combination of Gilham, Pintsov and Official Notice fails to disclose or render *prima facie* obvious all of the subject matter recited in claims 13-16, 18, 20, 21, 39, 41, 43, 44, 59-62, 64, 66, 67, 82-85, 87, 89, and 90. For example, claims 2-23 depend from independent claim 1, claims 25-46 depend from independent claim 24, claims 48-69 depend from independent claim 47 and claims 71-92 depend from independent claim 70 and should be patentably distinguishable from Gilham, Pintsov and Official Notice for at least the reasons outlined above with respect to the rejections of independent claims 1, 24, 47 and 70 based on Gilham and Pintsov. Moreover, the Official Notice relied upon in the rejection statement fails to supply the subject matter recited in claims 1, 24, 47 and 70 that is not supplied by Gilham and Pintsov. For at least this reason, claims 13-16, 18, 20, 21, 39, 41, 43, 44, 59-62, 64, 66, 67, 82-85, 87, 89, and 90 are not *prima facie* obvious based on the Gilham, Pintsov and Official Notice references, regardless of whether they are viewed individually or as a whole. Thus, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 13-16, 18, 20, 21, 39, 41, 43, 44, 59-62, 64, 66, 67, 82-85, 87, 89, and 90 under 35 U.S.C. § 103(a).

IV. Conclusion

For at least the above-outlined reasons, Applicant's independent claims 1, 24, 47 and 70 should be allowable. Pending dependent claims 2-23, 25-46, 48-69 and 71-92 depend from a corresponding one of the allowable independent claims. Therefore, those dependent claims should be allowable for at least the same reasons the corresponding independent claims are allowable.

Applicant respectfully requests the reconsideration of the application, withdrawal of the claim rejections, and timely allowance of pending claims 1-92.

If the Examiner believes that a conversation might advance prosecution of this application, the Examiner is cordially invited to call Applicant's undersigned attorney at (404) 653-6400.

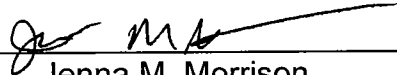
Please grant any extensions of time required to enter this Response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: August 6, 2009

By: _____


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